

Appl. No. 10/035,662
Amdt. Dated April 4, 2005
Reply to Office action of November 2, 2004

REMARKS/ARGUMENTS

Claims 16-18, 85 and 86 are pending in the Application. As set forth more fully below, reconsideration and withdrawal of the Examiner's rejections of the claims are respectfully requested.

Objection to the Specification

The Examiner has objected to the disclosure as containing the symbol "∞" in reference to degrees celsius and in making reference to Figure 8 which is not included in the disclosure. Applicants have amended the specification to insert the issued patent number of the parent patent application, to replace the symbol "∞" and to remove the reference to Figure 8.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected Claims 17 and 18 under 35 U.S.C. § 112, first paragraph, as lacking enablement for the induction of apoptosis by the compound Pya-Bip-Atmp and for the treatment of a mammal having a cancer other than small cell lung cancer with this compound. Applicants have amended Claim 17 to recite the inhibition of small cell lung cancer growth in a mammal in need of such treatment. Applicants submit that the specification provides adequate enablement for the recited methods of Claims 17 and 18 at least in Examples XIX.

The Examiner has also rejected Claims 17 and 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended Claim 17 to recite the inhibition of small cell lung cancer growth in a mammal in need of such treatment by the administration of an effective amount of Pya-Bip-Atmp.

In view of the foregoing remarks, applicants submit that there is adequate enablement and written description in the specification for Claims 17 and 18, as amended, and request the Examiner's rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected Claims 16-18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner states that reference to the formula

Appl. No. 10/035,662
Amdt. Dated April 4, 2005
Reply to Office action of November 2, 2004

"Pya-Bip-Atmp" in Claim 16 is not clear and that Claim 17 requires the recitation of an effective amount of the compound for administration to the mammal being treated. Applicants have amended Claim 16 to recite the full name of the compound: "trans-3-(3-pyridyl)acryloyl – biphenylalanine – 4-amino-2,2,6,6-tetramethylpiperidine." Applicants have also amended Claim 17 to recite the administration of an effective amount of the compound of Claim 16. Applicants therefore submit that Claims 16-18, as amended, are sufficiently definite to comply with the requirement of requirements of 35 U.S.C. § 112, second paragraph, and the Examiner's rejections of these claims should be withdrawn.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: Robert D. Traver

Robert D. Traver
Registration No. 47,999
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: 4 April 2005